

## PATENT COOPERATION TREATY

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## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 12884WO/mi		<b>FOR FURTHER ACTION</b> See Form PCT/PEA/416	
International application No. PCT/EP2004/003001		International filing date (day/month/year) 22.03.2004	Priority date (day/month/year) 26.03.2003
International Patent Classification (IPC) or national classification and IPC C09D5/03, C09D163/00			
Applicant ATOTECH DEUTSCHLAND GMBH et al.			
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> sent to the applicant and to the International Bureau) a total of 1 sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>			
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>			
Date of submission of the demand  05.08.2005		Date of completion of this report  23.11.2005	
Name and mailing address of the International preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016		Authorized Officer  O'Sullivan, T  Telephone No. +31 70 340-2795	



**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/EP2004/003001

**Box No. I Basis of the report**

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
  - ☐ publication of the international application (under Rule 12.4)
  - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements\*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

**Description, Pages**

1-19 as originally filed

**Claims, Numbers**

5-44 as originally filed

1-4 received on 05.08.2005 with letter of 04.08.2005

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to sequence listing (*specify*):

4. ☒ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages
- ☒ the claims, Nos. 1
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to sequence listing (*specify*):

\* If item 4 applies, some or all of these sheets may be marked "superseded."

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**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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**1. Statement**

Novelty (N)	Yes: Claims	9,12,16-21,25,29-44
	No: Claims	1-8,10,11,13-15,22-24,26-28
Inventive step (IS)	Yes: Claims	
	No: Claims	1-44
Industrial applicability (IA)	Yes: Claims	1-44
	No: Claims	

**2. Citations and explanations (Rule 70.7):**

**see separate sheet**

## Section I

The amendments filed with the letter dated 05-08-05 introduce subject-matter which extends beyond the content of the application as filed, contrary to Article 34(2)(b) PCT.

The amendments concerned are the following:

I) Claim 1 - "***a glass transition temperature of at least 150°C in the cured state***"

This amendment would appear to be based on Claim 2 as originally filed. However in original Claim 2, a glass transition temperature of at least 150°C in the cured state is only disclosed for the coating concerned in conjunction with "***a glass transition temperature in the uncured state of at least 20°C.***" Since the present claim lacks reference to the T<sub>g</sub> in the uncured state, it's subject-matter is broader than that originally disclosed.

li) Claim 1 - "***at least one of an oxazine resin, a cyanate ester resin or a maleimide***".

It is considered that the clearest basis for this amendment lies in originally filed Claim 1 together with the original examples. These would appear to only provide a basis for binary mixtures i.e. Binder (as epoxy) plus cyanate, binder plus maleimide etc. To the extent that the present wording of the claim permits three or more component mixtures e.g binder plus cyanate plus maleimide, it would appear to contain added subject-matter.

## Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Reference is made to the following documents:

D6: US-A-5290882

i) The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1-8,10,11,13-15,22-24 and 26-28 is not new in the sense of Article 33(2) PCT.

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(SEPARATE SHEET)**

International application No.

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Table 4 of D1 discloses coating compositions comprising epoxy resins, bismaleimide resins and phenolic resins as curing agents. The coating compositions have glass transition temperatures (T<sub>g</sub>) in excess of 190°C after cure. Further, powder coatings are produced in D1 by mixing, melt-extrusion, cooling and milling of the of the composition (see column 18, line 30-40 in D1).

ii) The remaining claims in the present application would not appear to contain an inventive step as their salient subject-matter over the prior art would appear little more than a series of alternatives and modifications obvious to the skilled person. The subject-matter of these claims therefore does not meet the requirements of Art 33(3) PCT.